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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/886,197	06/21/2001	Shinichi Tsuboi	Mo5000ND/NIT-259-ND	9181

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EXAMINER

QAZI, SABIHA NAIM

ART UNIT	PAPER NUMBER
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1616

DATE MAILED: 08/10/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/886,197

Applicant(s)

TSUBOI ET AL.

Examiner

Sabiha Qazi

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 09 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 7,9,10,14 and 19-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 7,9,10,14 and 19-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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Non-Final Office Action

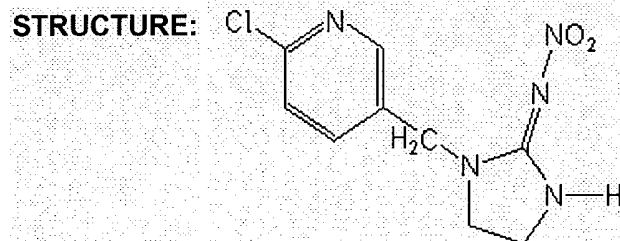
Acknowledgement is made of the Brief filed on 01/09/2004. Claims 7, 9, 10, 14, and 19-21 are pending and stand rejected. No claim is allowed. Finality of the action is withdrawn because a new reference being added to the rejection.

Rejections are maintained for the same reasons as set forth in our previous office action. The arguments were considered by the Examiner but are not found persuasive.

Examiner notes, that there is no data anywhere in the specification for the combination of imidacloprid and tebuconazole. The data represents only imidacloprid. There is no data for tebuconazole singly or in combination with imidacloprid.

imidacloprid

STATUS: ISO 1750 (published)
IUPAC: (EZ)-1-(6-chloro-3-pyridylmethyl)-N-nitroimidazolidin-2-ylideneamine
CAS: 1-[(6-chloro-3-pyridinyl)methyl]-N-nitro-2-imidazolidinimine
REG. NO.: 138261-41-3
FORMULA: C₉H₁₀ClN₅O₂
ACTIVITY: insecticides (nitroguanidine insecticides; pyridylmethylamine insecticides)

NOTES:**tebuconazole**

STATUS: ISO 1750 (published)
IUPAC: (RS)-1-p-chlorophenyl-4,4-dimethyl-3-(1H-1,2,4-triazol-1-ylmethyl)pentan-3-ol
CAS: α-[2-(4-chlorophenyl)ethyl]-α-(1,1-dimethylethyl)-1H-1,2,4-triazole-1-ethanol

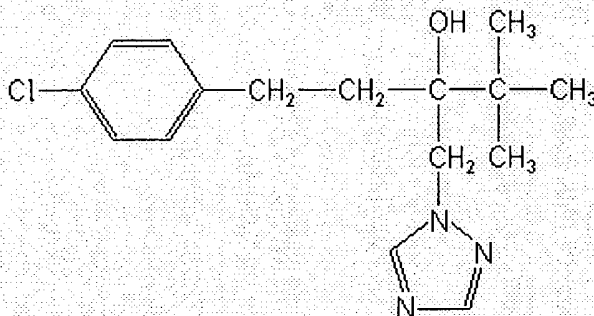
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REG. NO.: 107534-96-3

FORMULA: $C_{16}H_{22}ClN_3O$ ACTIVITY: fungicides (conazole fungicides)

NOTES:

STRUCTURE:



Rejection other than Double Patenting over Heuer et al. was withdrawn because of the priority date. Double Patenting rejection is appropriate as in presently claimed invention "comprising" allows other ingredients may be added.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary.

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Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 7, 9, 10, 14 and 19-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over United States Patent No. 4,742,060 (SHIOKAWA et al. United States Patent No. 4,731,385 (TSUBOI et al.) and Pesticide Manual, 9th edition, (WORTHING et al.). These references teach a composition and method which embraces Applicants claimed invention.

1. Shiokawa et al. (US Patent 4,742,060)

Shiokawa reference clearly teaches the imidacalprid (compound 11 (example 11 ii) in column 58), which is an old insecticide, applied to same locus (wood) of claims. See lines 45-49 in col. 51; lines 35 and 36 in col. 52; lines 61-67 in col. 53; lines 1-22 in col. 54. See column 12, lines 50-51 and 54, lines 18-20; the same compound is disclosed, see column 58, lines 30-35. See also the entire document, examples and claims.

The reference teaches that the compounds of the invention can be used as insecticides and can be used for control and eradication of wide range of pests. See lines 1-4 in col. 51;

Shiokawa teach the ranges as presently claimed, see lines 10-15 in column 54, where active compounds concentration for use can be 0.0000001 to 100% by weight of the active compound. The reference also teaches that same insects for treatments (disclosed on pages 6 and 7 of present specification) may be combated; see lines 60-67, col. 53. It also teaches that that the other active compounds such as fungicides may be combined with imidazolidine insecticides.

2. Worthing et al. (Pesticide Manual, 9th edition)

The reference teaches that a fungicide may be used in combination with the said imidazolidine compound. Worthing reference teaches that the fungicides such as tebuconazole are well known. This reference is used to show that fungicide tebuconazole is a well-known fungicide. Since fungicide tebuconazole is a known fungicide therefore, in view of teachings of Shiokawa, Tsuboi and Worthing references one skilled in the art would be motivated to combine the imidazolidine compound of formula (as compound 11) and a fungicide tebuconazole.

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3. Tsuboi et al. (US 4,731,385)

The reference teaches an insecticidal and fungicidal composition containing imidacloprid and other fungicides. Furthermore, it teaches that activities of nitromethylenes and fungicidal compounds are not essentially satisfactory especially when concentrations of these active compounds are low and when they are used in small amounts. The active compounds show either insecticidal or fungicidal effect when used singly and cannot simultaneously control diseases caused by pathogens and damage caused by insects. The combinations exhibit simultaneously excellent insecticidal and fungicidal effects against insects and diseases on agricultural crops. See lines 58-66 in col. 1 and lines 49-65 in col. 2. See also the entire document especially examples and claims.

It is *prima facie* obvious to combine the compositions each of which is taught by the prior art to be useful for the same purpose in order to form a new composition that is to be used for the very same purpose; the idea of combining them flows logically from their having been individually taught in the prior art. In re Kerkhoven, 205 USPQ 1069. There is nothing inventive in a composition of old ingredients of known properties with each ingredient functioning individually as expected. In re Sussman. 58 USPQ 262.

Therefore, the claimed invention, as a whole would have been *prima facie* obvious to one skill in the art at the time of the invention was made, because every element of the invention and the claimed invention as a whole is fairly suggested by the combined teachings of the references.

As a matter of fact there is no evidence or data of imidacloprid + tebuconazol combination. Specification discloses the data of compounds 1.1, 1.2, 1.3 and comparable with comparative compounds A and B. There is no data for the combination as claimed. Compound 1.3 is imidacloprid, the data of which is disclosed. There is no data for tebuconazole or imidacloprid + tebuconazole.

In the light of the forgoing discussion, the Examiner's ultimate legal conclusion is that the subject matter defined by the instant claims would have been obvious within the meaning of 35 U.S.C. 103(a).

A reference is good not only for what it teaches by direct anticipation but also for what one of ordinary skill might reasonably infer from the teachings. *In re opprecht* 12 USPQ 2d 1235, 1236 (Fed Cir.

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1989); *In re Bode* 193 USPQ 12 (CCPA 1976). A reference is not limited to working examples. *In re Fracalossi* 215 USPQ 569 (CCPA 1982).

Accordingly, the burden of proof is upon applicants to show that instantly claimed subject matter is different and unobvious over those taught by prior art. See *In re Brown*, 173 USPQ 685, 688; *In re Best*, 195 USPQ 430 and *In re Marosi*, 218 USPQ 289, 293.

Double Patenting

Claims 7, 9, 10, 14, and 19-21 stand rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-5 of U.S. Patent No. 5,972,971 for the same reasons as set forth in our previous office action.

Although the conflicting claims are not identical, they are not patentably distinct from each other because claims of US '971 is drawn to a method and composition for preserving wood or timber products by using the combination of imidacloprid (compound listed as b in claim 1) and an azole compound.

Since the term "comprising" is cited in claims, which is inclusive and fails to exclude unrecited steps. The use of the term comprising to introduce claimed structure means that the ingredients covered by these claims may involve more elements than those positively recited. *Ex parte Gottzein et al.*, 168 USPQ 176 (PTO Bd. App. 1969). Comprising leaves the claim open for inclusion of unspecified ingredients even in major amounts. *Ex parte Davis et al.*, 80 USPQ 448 (PTO Bd. App. 1948). Therefore even if the third ingredient is not mentioned in the claims, claims are considered obvious because of the term "comprising".

Claim 3 further give a list, which includes tebuconazole (compound listed as d). US '971 claims the synergistic compositions. See in claim 1, compound b) which is imidacloprid and in claim 3, compound d) which is tebuconazole. Same combination of compounds is claimed in present invention for preserving woods or timber products derived from wood (see claim 5).

Instant claims after amendments are narrower and selection of the claims of US '971.

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It would have been obvious to one skilled in the art to prepare a composition by combining imidacloprid and tebuconazole for preservation of wood or wood products because the reference teaches the same use.


Present invention has the same assignee.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sabiha Qazi whose telephone number is (571) 272-0622. The examiner can normally be reached on any business day.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Kunz can be reached on (571) 272-0887. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Monday, August 9, 2004


SABIHA QAZI, PH.D
PRIMARY EXAMINER